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DATE: December 19, 2003

TO: Art Unit 1636
MAIL STOP Non-Fee Amendment

COMPANY: USPTO

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FROM: Heidi S. Nebel

NUMBER OF PAGES (Including cover): 4

COMMENTS: Please file the attached RESPONSE TO RESTRICTION REQUIREMENT:

APPLICANT : Ng et al.
SERIAL NO : 10/004,968
FILED : December 5, 2001
TITLE : METHODS AND COMPOSITIONS FOR HIGHLY
EFFICIENT PRODUCTION OF HETEROLOGOUS
PROTEINS IN YEAST

Grp./A.U. : 1636
Examiner : VOGEL, Nancy T.
Conf. No. : 7842
Docket No. : P05424US1

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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement dated November 20, 2003, Applicants hereby provisionally elect Group I with traverse. Please consider the following remarks in the above-identified application.

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

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Date: 12-19-2003

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HEIDI S. NEBEL

REMARKS

The Examiner has restricted this application to one of the following inventions under 35 U.S.C. § 121:

- I. Claims 1-12, 15-23, and 26-31, drawn to a method of making a heterologous protein in fungi;
- II. Claims 13, 24, 32, and 34-42, drawn to a mutant yeast, and a transformed yeast, and a vector; and
- III. Claims 14, 25, and 33, drawn to a protein.

The Examiner states the inventions are distinct for the following reasons:

The products of Group II and the product of Group III are chemically, biologically, and functionally distinct from each other and thus one does not render the other obvious. The product of each group is not needed to produce the products of the other groups. Therefore, the inventions of the groups are capable of supporting separate patents.

Inventions of Group I and III are related as process of making and product made. In the instant case, the product as claimed can be made by an in vitro chemical synthesis technique such as Merrifield synthesis.

Inventions of Group II and I are related as product and process of use. In the instant case, the product as claimed can be used as a hybridization probe in hybridization studies. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Furthermore, especially in instances where the classifications are the same, the non-patent literature searches required for each of these inventions are not co-extensive, hence said searches would be burdensome. Therefore, restriction for examination purposes as indicated is proper.

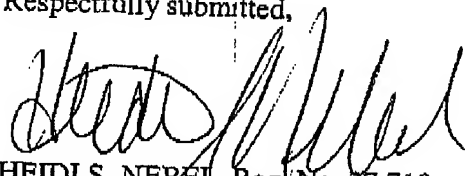
PTO Paper dated November 20, 2003 at pp. 2-3.

Applicants respectfully submit that no separate search is required to search the non-elected inventions as all the claims are generally directed to heterologous proteins in fungi and can be reviewed in a single search. Reconsideration is requested.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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